

### **REMARKS**

Claims 1-27 are pending. By this amendment, claims 1, 9, 18 and 22 are amended. No new matter is introduced. Reconsideration and prompt allowance of the pending claims are respectfully requested.

Applicants thank Examiner Ke and Kincaid for the courtesies extended to Applicants' representative during a March 16, 2004 personal interview. The substance of the interview is included in the remarks that follow.

#### **35 U.S.C. § 102 Rejections**

Claims 22 and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,588,104 to Lanier et al. (hereinafter "Lanier I") for reasons stated on pages 2-3 of the Office Action. Applicants respectfully traverse the rejection.

For anticipation under 35 U.S.C. § 102, the reference "must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." (MPEP § 706.02). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic Research & Foundation v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Lanier I describes a method and apparatus for creating virtual worlds using a data flow network. The method uses a computer terminal to display the data flow network as a plurality of interconnected units. An interactive program allows the appearance of the plurality of interconnected units to be changed. The data flow network then is automatically altered to correspond with the visual changes. As discussed during the personal interview, Lanier I does not disclose or suggest using a viewer's terminal of a television delivery system, as recited in claims 22 and 25. In fact, one skilled in the art could easily understand that the method and apparatus of Lanier I is specifically designed for computer terminals that are capable of handling large amount of data, but not for television terminals with limited data processing ability. Lanier's method creates virtual worlds at a user's terminal so that the user may manipulate pictorial objects on a computer screen to effect complicated operations on the virtual world database (see column 1, lines 36-39 of Lanier I). In the instant invention,

the television terminal simply receives virtual objects from the television delivery system. Since Lanier I does not disclose or suggest all of the elements of claims 22 and 25, claims 22 and 25 are allowable over Lanier I. Withdrawal of the rejection of claims 22 and 25 under 35 U.S.C. §102(e) is respectfully requested.

### **35 U.S.C. § 103 Rejections**

Claims 1-6, 8-14, 16-21, 23, 24, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lanier I in view of U.S. Patent 5,588,139 to Lanier et al. (hereinafter "Lanier II") for reasons stated on pages 3-9 of the Office Action. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP § 2142. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and MPEP § 2143.03.

As discussed earlier, Lanier I does not disclose or suggest using a viewer's terminal of a television delivery system, as disclosed in independent claims 1, 9, 18 and 22. Lanier II does not cure this defect.

Lanier II is directed to a computer model for generating objects for a multi-person virtual world using data flow networks. Similar to Lanier I, the method and apparatus described in Lanier II are specifically designed for computer terminals. Lanier II actually teaches away from receiving a virtual world from a television delivery system because it is directed to a simulating method and apparatus that creates a multi-person virtual world on a display terminal using a computer at the user's site, as evidenced by over seventeen hundred pages of the source listings in the patent.

Accordingly, Lanier I and II, alone and in combination, do not disclose or suggest receiving virtual subjects or video programs or both from a television delivery system. Claims 1, 9, 18 and 22 are allowable over Lanier I and II. Withdrawal of the 35 U.S.C. 103(a) rejection to claims 1, 9 and 18 is respectfully requested.

If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and MPEP § 2143.03. Claims 2-6 and 8 depend from claim 1. Claims 10-14 and 16-17 depend from claim 9. Claims 19-21 depend from claim 18. Claims 23, 24, 26 and 27 depend from claim 22. Accordingly, Applicants submit that claims 2-6, 8, 10-14, 16-17, 19-21, 23, 24, 26, and 27 are allowable because they depend from allowable claims, and for the

additional features they recite. Withdrawal of the 35 U.S.C. 103(a) rejection to claims 2-6, 8, 10-14, 16-17, 19-21, 23, 24, 26, and 27 is respectfully requested.

Claims 7 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lanier I in view of Lanier II and further in view of US Patent No. 5,737,533 to de Hond (hereinafter "de Hond") for reasons stated on page 9 of the Office Action. Applicants respectfully traverse the rejection.

Claim 7 depends from claim 1. Claim 16 depends from claim 9. As discussed earlier, claims 1 and 9 are allowable over Lanier I and II. Therefore, claims 7 and 9 are allowable over Lanier I and II. De Hond describes a system for database search that comprises, among other things, a server and a database. De Hond does not teach or suggest receiving virtual objects from a television delivery system and therefore, does not cure the defect of Lanier I and II. Accordingly, claims 7 and 16 are allowable because they depend from allowable claims 1 and 9, respectfully, and for the additional features they recite. Withdrawal of the rejection of claims 7 and 16 under 35 U.S.C. §103 (a) is respectfully requested.

In view of the above remarks, Applicants respectfully submit that the application is in condition for allowance. Prompt examination and allowance are respectfully requested. Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

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Respectfully submitted,



Date: March 22, 2004

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